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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,544	04/15/2004	Yutaka Nagao	251896US6	6525

22850 7590 11/29/2007

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EXAMINER	
WORJLOH, JALATEE	

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
11/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/824,544	NAGAO, YUTAKA	
	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 8-27-07.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,3-9 and 11-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,3-9 and 11-15 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed August 27, 2007. Claims 2 and 10 were canceled; claims 1, 3-9 and 11-15 were amended and are pending.

Response to Arguments

2. Applicant's arguments filed August 27, 2007 have been fully considered but they are not persuasive.

3. Applicant argues that the references fail to show (Chase fails to teach or suggest a second license that serves as an update of said first license or reference a determining step used to indicate how the second license should modify the first".), it is noted that the features upon which Applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant argues that Chase does not describe or suggest combining the first license information and the second license information

The Examiner respectfully disagrees. Chase teaches a license with rights and rules (i.e. usage information) (see col. 5, lines 66 & 67; col. 3, lines 13-20 and col. 4, lines 8-19) and a license with the modification string (see col. 4, lines 20-50). Thus, both the rights/rules and the modification string are included in the license; thus, they are combined.

5. Applicant argues that the modification string is not a license.

Notice, the claims recites "second license information" not license. Thus, the Examiner interprets as the modification string as second license information not license. The modification

string includes modification information for modifying the rendering license, which is second license information (see col. 4, lines 20-25).

6. Applicant argues that Chase does not expressly disclose determining whether the second license information is an add attribute or overwrite attribute against the first license information.

The Examiner notes that this feature is new matter (see 35 USC 112 rejection below). However, this is taught by Chase (see col. 4, lines 27-36). The modification string includes the identifying indicia and a modification script including a set of instructions to be processed with respect to the license. Thus, the instructions determines how the information should be processed (i.e. add or overwrite).

Claim Rejections - 35 USC § 112

7. Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: combining the first license information and the second license information.

8. Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites "determining whether the second license information is an add attribute or overwrite attribute against the first license information *used to combine* the first license information and the second license information"; however, the claim does not show first and second information being combined.

Also, it unclear what applicant means by "against the first license information". Is the second information being compared to the first license information?

10. Claims 3-8 depends on claim 1; therefore, these claims are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

11. As for claim 5, what is the "key information unique to said information processing apparatus"?

Claim Rejections - 35 USC § 112

12. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "determining whether the second license information is an add attribute or overwrite attribute against the first license information used to combine the first license information and the second license information"; however, the specification does not disclose the determining "against the first license information used to combine the first license information and the second license information". If Applicant disagrees, please clearly identify where this feature is taught in the specification.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 9, and 15 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7110985 to Chase et al. ("Chase").

Referring to claim 1, Chase discloses storage means for storing first license information corresponding to the content information (see col. 3, lines 13-20 & col. 4, lines 8-19 – the storage device stores the license, which includes rights information), receiving means for receiving second license information corresponding to the content information (the computing device receives the modification string) and licensing processing means for determining whether the second license information is an add attribute or overwrite attribute against the first license information used to combine the first license information and the second license information (see col. 4, lines 27-36 – the modification string includes the identifying indicia and a modification script including a set of instructions to be processed with respect to the license),wherein the content information is operated within a range of license information obtained by combining the first license information obtained by combining the first license information and second license information (the content is used based on the modification string, which is within the range) (see claim 1 & col. 4, lines 20-50)

Referring to claim 9, Chase discloses storing first license information corresponding to the content information, receiving second license information corresponding to the content information, determining whether said second license information is an add attribute or an overwrite attribute against the first license information and combining a part of all of said second license information with the first license information on the basis of a result of the attribute

determination made in said determining step, wherein said content information is used within a range of license information obtained by the combining the first license information with said second license information in said linking step (see claims 1 & 2 above).

Claim 15 is a system that performs the process of claim 1 above; therefore, this claim is rejected on the same rationale as claim 1 above.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 3, 4, 6-8, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase as applied to claim 2 above, and further in view of US Publication No. 2002/0026424 to Akashi.

Referring to claim 3, Chase discloses second license information (see claim 2 above – modification string). Chase does not expressly disclose wherein when the said second license information is determined to be an overwrite attribute, the processing means writes a part or all of the second license information over said first license information. Akashi discloses overwriting license information (see paragraph [0044]). As for overwriting the first license information with the second license information this is considered nonfunctional descriptive material. The overwriting step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re*

Lowry, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to overwrite information with any type of content because of the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 4, Chase discloses second license information (see claim 2 above – modification string). Chase does not expressly disclose when the second license information is determined to be the add attribute, the processing means adds a part or all the second license information to the first license information. Akashi discloses overwriting license information (see paragraph [0044]). As for adding the second license information to the first license information, the overwriting concept of Akashi in combination with the modification script including the instruction set of Chase will allow such process to occur. Thus, at the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus taught by Chase to include the apparatus wherein if said second license information is found by said second license identification information to be the license information to be added, the linking means adds a part or all of said license information to said first license information. One of ordinary skill in the art would have been motivated to do this because the correct contents use condition can be retained (see paragraph [0045] of Akashi).

Claims 6-8, 12-14 are rejected on the same rationale as claim 4 above.

Claims 10 and 11 are method claims that performs the process in claims 3 and 4, respectively; therefore, these claims are rejected on the same rationale as claims 3 and 4 above.

17. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase as applied to claim 1 above.

Chase discloses a license including a digital signature (see col. 3, lines 13-20). Chase does not expressly disclose the use of key information unique to said information processing apparatus, an electronic signature is appended to license information obtained by combining the first license information with said second license information by said license processing means. Akashi discloses overwriting license information (see paragraph [0044]). As for appending electronic signature to the license information, the overwriting concept of Akashi in combination with the modification script including the instruction set of Chase will allow such process to occur. Thus, at the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus taught by Chase to include the apparatus wherein by the use of key information unique to said information processing apparatus, an electronic signature is appended to license information obtained by linking said first license information with said second license information by said linking means. One of ordinary skill in the art would have been motivated to do this because the correct contents use condition can be retained (see paragraph [0045] of Akashi).

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jalatee Worjloh
Primary Examiner
Art Unit 3621

November 26, 2007